REMARKS

The amendments to the specification do not add any new matter, but merely clarify that a "copy" is a "duplicate". It is well known that a synonym for the term "copy" is the term "duplicate."

With respect to the amendments to the claims, claims 1-34 were initially pending. No claims have been amended. No claims have been canceled. Claims 35-67 have been added. Accordingly, claims 1-67 are currently pending.

Although the 3/16/04 Office action is a non-final Office action, Applicant has included a request for continuing examination (RCE) under 37 CFR §1.114 to expedite examination of new claims 35-67.

Withdrawal of all rejections and objections to the pending claims and allowance of the pending claims is respectfully requested in view of the following arguments.

Claim Rejections Under 35 USC §103(A)

Claims 1-34 stand rejected under 35 USC §103(a) as being unpatentable over U.S. Patent No. 6,356,903 to Baxter et al ("Baxter") in view of Official notice used to modify Baxter. These rejections are traversed.

A fundamental aspect of patent law is that "[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally avail-able to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the

claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." (MPEP §2143). Baxter in view of the modification to Baxter made by the Office does not present such a prima facie case of obviousness of the pending claims at least for the following reasons.

Claim 1 recites "receiving, by the server computer, a request from the client computer for one or more requested content items", and "responsive to receiving the request: identifying, by the server computer, a data structure that refers to one or more further content items", "modifying, by the server computer, the data structure to reference the requested content items", and "providing, by the server computer, the content items referenced by the modified data structure to the client computer." Nowhere does the cited combination teach or suggest these claimed features.

In addressing claim 1, the Action admits that Baxter does not teach "modifying, by the server computer, the data structure to reference the requested content items", as claim 1 recites. Instead, and without pointing to any specific teaching or suggestion in Baxter, the Action modifies Baxter – asserting that "it is well known to modify a data structure to reference requested content items." However, it is not proper to modify the structure of a patent reference to one which the prior art reference does not suggest. Baxter does not provide any motivation for this modification to Baxter.

More particularly, Baxter teaches at col. 17, lines 6-10 that "[t]he process starts in step S32 when a user requests information contained in the content management system." Thereafter, in step S33, the system interprets the request and retrieves personalization information for assembly. The personalization

information can retrieved [sic] based upon information from the user contained, for example, in cookies, passwords, or other types user identification." Figure 9 of Baxter teaches that the retrieved personalization information includes a "user profile", a "customer segment group", a "test group", a "personalization strategy", and "messages for user based on test group". Assuming that this personalization information represents one or more data structures, Baxter does not teach that any of these data structures are then modified to reference the information provided by the user request. Instead, operation S334 of Fig. 9 teaches that this personalization information is then returned to "system to be assembled along with other document and border components".

Clearly, this teaching of Baxter does provide any motivation for a person of ordinary skill in the art at the time of invention to change Baxter to modify the retrieved personalization information to reference any information contained in the user request. Modification unwarranted by the disclosure of a reference is unwarranted and prior art patents are references only for what they clearly disclose or suggest. Baxter teaches only that the user request is used only to identify the personalization information. Thus, it is respectfully submitted that the modification to Baxter (i.e., "modifying [...] the data structure to reference the requested content items") was not found in the prior art, but rather based on impermissible hindsight analysis of applicant's disclosure. Thus, Baxter cannot be combined in the manner suggested to support a 35 USC §103 rejection of claim 1.

As an additional matter, to provide a missing feature of claim 1, the Office indicates that "it would have been obvious [...] to use the method of modifying the retrieved content and apply it to the data structure, and the motivation will be allowing users to modify the requested data according to their needs." However,

claim 1 does not recite features of "modifying the retrieved content and apply it to the data structure" as the Office asserts. Rather, claim 1 recites "a request from the client computer for one or more requested content items". Neither the "request" nor the "one or more requested content items" are retrieved content, as erroneously cast by the Action. Rather, claim 1 recites "receiving [...] a request from a client computer for one or more content items", "identifying [...] a data structure that refers to one or more further content items", and "modifying [...] the data structure to reference the requested content items. Nowhere does these recited features "modifying the retrieved content and apply it to the data structure" as the Office asserts.

For these additional reasons, Baxter cannot be combined in the manner suggested by the Office to support a 35 USC §103 rejection of claim 1.

Moreover, for the reasons already discussed, nowhere does the cited combination teach or suggest "providing, by the server computer, the content items referenced by the modified data structure to the client computer".

Accordingly, and for each of the above reasons, the 35 USC §103(a) rejection of claim 1 is improper and should be withdrawn.

As an additional matter, the Office seemingly relies on personal knowledge in modifying to Baxter to supply admittedly missing features without pointing to any specific teaching or suggestion in Baxter to support the modification.

> *"When a rejection in an application is based on facts within the personal knowledge of an employee of the office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and*

such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons." 37 CFR §1.104(d)(2).

If this rejection is maintained on a similar basis in a subsequent action, Applicant respectfully requests the Examiner to supply such an affidavit to support this modification to Baxter.

Claims 2-9 depend from claim 1 and are allowable over Baxter in view of the Examiner's modification (the "modification") by virtue of this dependency. For this reason alone, the 35 USC §103(a) rejection of claims 2-9 should be withdrawn. Moreover, claims 2-9 include additional subject matter that is not described by Baxter in view of the Examiners modification to Baxter.

For instance, **claim 2** recites "wherein identifying the data structure, the data structure comprises a playlist", "wherein receiving the request, the one or more requested content items comprises streaming media content", and "wherein providing the content items further comprises streaming the content items referred to by the playlist." Nowhere does Baxter in view of the modification describe "a playlist", "streaming media content", or "streaming the content items referred to by the playlist."

In addressing this feature, the ACTION asserts that Baxter teaches the claimed "playlist" in col. 5, lines 4-13. This assertion is unsupportable. It is respectfully submitted that Baxter's description of a "content management repository server" which maintains an index cross referencing content allowing content to be stored on a variety of devices sounds more like a directory service. Merely citing types of content indexed and cross-referenced by such "content

management repository server" such as "video, movies, and audio, as well as a traditional data storage unit ..." does not teach "a playlist", as Applicant claims.

The specification at page 2, line 9, through page 3, line 18 describes a playlist and the types of environments where a playlist is used. In particular the specification indicates that a playlist, or 'playlist file' that includes a number of different references to individual streaming media content files. Playlists do not normally contain the actual media data, but rather particular references (i.e., a URL) to stored media data. Each playlist file includes information such as information to reference specific pieces of content, an order in which to play the referenced content, and other information (e.g., whether to play certain pieces of referenced content more than one time). In other words, a playlist file not only references media content, but also describes how pieces of media content are combined. In view of this explicit description in the specification, it is clear that the server of Baxter used to index and cross reference "video, movies, and audio" does not describe the claimed "a playlist".

For this additional reason, claim 2 is not unpatentable over Baxter in view of the modification and the 35 USC §103(a) rejection of claim 2 should be withdrawn.

Claim 3 also recites features that are not unpatentable over Baxter in view of the modification. For instance, claim 3 recites "wherein identifying the data structure, the data structure comprises a first Web page specification, and the requested content comprises a second Web page specification." In addressing these features, the ACTION points to col. 6, lines 63-65 of Baxter to assert that Baxter teaches these claimed features. Applicant disagrees.

At col. 6, lines 63-65, Baxter merely teaches that "[t]he data structure shown in FIG. 4 ties together documents, outlines, styles and templates and styles for use." Applicant respectfully submits that the data structure of FIG. 4 merely describes a data structure with a site ID, a site name, a site description, a trigger ID, and a last review date. Nowhere does this teaching describe "wherein identifying the data structure, the data structure comprises a first Web page specification, and the requested content comprises a second Web page specification." Thus, a system of Baxter may never have a "data structure comprises a first Web page specification, and the requested content comprises a second Web page specification", "the requested content" being comprised in "a request from the client", as claim 3 recites.

For this additional reason, claim 3 is not unpatentable over Baxter in view of the modification and the 35 USC §103(a) rejection of claim 3 should be withdrawn.

The ACTION has not provided any rational for rejection **claims 4-34** other than what was presented in the August 22, Office Action. The response to that action provided reasons and arguments why these claims were not unpatentable over Baxter. These reasons and arguments are not repeated verbatim herein, but incorporated by reference and are to be considered in view of the arguments presented herein that further support patentability of the claims over the cited combination.

New **claims 35-67** are allowable in view of the references of record for the reasons already discussed.

Conclusion

Claims 1-67 are in condition for allowance and action to that end is respectfully requested. Should any issue remain that prevents allowance of the application, the Office is encouraged to contact the undersigned.

Respectfully Submitted,

Dated: _7/16/04_   By: _Brian Hart_

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